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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/676,250	10/02/2003	Kenichiro Uda	041094-5022	3462
9629	7590	08/08/2006	EXAMINER	
MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			POULOS, SANDRA K	
			ART UNIT	PAPER NUMBER

1714

DATE MAILED: 08/08/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/676,250

Applicant(s)

UDA ET AL.

Examiner

Sandra K. Poulos

Art Unit

1714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 5-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 5-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date: _____  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>6-29-06</u>   | 6) <input type="checkbox"/> Other: _____                                    |

### **DETAILED ACTION**

1. All outstanding rejections and objections except for those described below are overcome by applicant's amendment filed 5/23/06.
2. The new grounds of rejection set forth below are necessitated by applicant's amendment filed 5/23/06. In particular, claim 1 is amended to be further limited such that the high polymer is compound does not contain a nonionic polymer. Thus the following action is properly made **FINAL**.

### ***Specification***

3. The amendment filed 5/23/06 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The abstract recites that the composition does not contain a non-ionic polymer.

Applicant is required to cancel the new matter in the reply to this Office Action.

4. The disclosure is objected to as set forth in paragraph 2(a) of the Office Action mailed 1/27/06. "Isobutylene" is a misspelling that is present in Example 1 in Tables 1 and 2. It should be corrected to "isobutylene".

Appropriate correction is required.

Art Unit: 1714

***Claim Objections***

5. Claim 1 is objected to because of the following informalities: Claim 1 recites an improper Markush group. "Selected from among" should be "selected from the group consisting of".

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, 5-9 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claims 1 and new claim 7 recite "said high polymer compound does not comprise a nonionic polymer compound". It is the examiner's position that this phrase fails to satisfy the written description requirement of 35 USC 112, first paragraph since there does not appear to be a written description requirement of the phrase "does not comprise a nonionic polymer compound" in the application as originally filed, *In re Wright*, 866 F.2d 422, 9 USPQ2d 1649 (Fed. Cir. 1989) and MPEP 2163. Applicant has argued that there is support for this limitation because there is no reference to nonionic polymer compounds in the application and the examples do not include a nonionic polymer. This is not sufficient support for the newly added phrase above. Note MPEP 2173.05(i) which states that "[t]he mere absence of a positive recitation is not basis for an exclusion."

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1, 2, 5-9 rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2003-206493 in view of Harada JP 2002-265974.

JP 493 discloses a water soluble lubricant for warm or hot plastic working and in for use with metals (para 1-2, 6) and contains (a) a sodium salt of an anionic polymer (such as an acrylic acid-maleic acid copolymer) having an average molecular weight of 10,000 to 1,000,000 in an amount of 1 to 50% of the lubricant and (b) a sodium salt of an anionic polymer having a molecular weight of 500 to 10,000 (such as isobutylene-maleic acid copolymer) in an amount of 0.2-30% (abstract).

JP 493 does not disclose imidating the copolymer.

JP 974 discloses a water-soluble lubricant for warm or hot plastic working, which is excellent in lubricity and mold release properties, can control the deposition of a metal, and does not worsen the working environment and the operating efficiency (abstract; paragraph 3). The content of the high polymer is 0.7-80 wt% based on 100 wt% of the lubricant (paragraph 19). JP 974 discloses that the polymer includes imide groups (paragraphs 9, 13). In the examples, a lubricant is prepared from an isobutylene/maleic anhydride copolymer having a mean molecular weight of 90,000 and an imidation ratio of 50% (paragraph 21). Ammonium is used as the imidation agent (para 9, 14) resulting in a salt of an anionic maleic anhydride copolymer.

It would have been obvious to one of ordinary skill in the art to imidate the copolymer in JP 493 in the ratio given above using ammonium because the inventive examples in JP 974 that

Art Unit: 1714

use the imidized copolymer excel in lubricity, mold release characteristics, metal deposition control, and is useful for plastic working.

### ***Response to Arguments***

Applicant's amendment has resulted in the withdrawal of the rejection set forth in the Office Action mailed 1/27/06, therefore, applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection set forth above.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

JP 01-094936 discloses a copolymer comprising a maleic acid monomer unit and a monomer selected from isobutylene, styrene, and acrylic acid. The copolymer has a molecular

Art Unit: 1714

weight of from 1000-20,000 and a content of maleic acid monomer of 5-70 mol%. An imido treatment is applied to the copolymer. The copolymer is used as a dispersing agent.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sandra K. Poulos whose telephone number is (571) 272-6428. The examiner can normally be reached on M-F 8:00-4:30 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (571) 272-1119. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SKP

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